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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,367	10/22/2003	Michael A. McCabe	2002-IP-008009U1	1396

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EXAMINER

BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



<b>Office Action Summary</b>	<b>Application No.</b> 10/691,367	<b>Applicant(s)</b> MCCABE ET AL.	
	<b>Examiner</b> David Buttner	<b>Art Unit</b> 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24,25,27,28 and 31-52 is/are pending in the application.
- 4a) Of the above claim(s) 36-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24,25,27,28,31-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Newly submitted claims 36-52 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- I. Claims 24,25,27,28,31-35, drawn to a composition, classified in class 507, subclass 217.
- II. Claims 36-52, drawn to treating subterranean zones, classified in class 507, subclass 217.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case product could be used as thickener foods, cosmetics etc.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 36-52 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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RCE practice does not permit continued examination on claims that are independent and distinct from the original claims. See MPEP 706.07(h).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 24,25,27,28 and 31-35 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These composition claims are limited by certain behaviors in a subterranean zone. However, the precise conditions of this subterranean zone are not specified. Temperature, pH, other materials in the subterranean zone would all have affect whether the composition would remain devoid of insolubles. A single composition could conceivably have insolubles in some subterranean zones but none in other subterranean zones.

Claims 24,25,27,28 and 31-35 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yeh '825.

Yeh produces polygalactomannan which transmits light (abstract). The light transmission is believed to be due to the lowered insolubles (col 1 line 45;col 2 line 67; col 6 line 34). Yeh's method involves treating a material such as hydroxypropylguar (col 5 line 42) with a solution of NaOH (col 4 line 26-41). At this point in Yeh's process, applicant's composition claims are met. Yeh's later drying steps do not detract from the rejection.

Claims 24,25,27,28 and 31-35 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gupta '832.

Gupta claims (#1,2) fracturing subterranean formations with an aqueous fluid of gelling agent and crosslinking agent at a pH of 10-12. According to applicant (paragraph 6) this pH causes the insoluble residues to dissolve. Presumably, Gupta would inherently be devoid of insoluble residues also. Note that applicant does not consider crosslinkers to be insoluble gelling agent (paragraph 17 of spec).

Claims 24,25,27,28 and 31-35 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Briscoe '145.

Briscoe exemplifies liquid gel concentrates (table I) of hydroxypropylguar, water, NaOH and optionally inhibitor. Also table III has an example solely containing guar gum, NaOH and water. The pH of the mixture is 9-14 (col 10 line 27). This envelops applicant's preferred pH range of "about 10-13" (claim 34). According to applicant (paragraph 6) this pH causes the insoluble residues to dissolve. Presumably, Briscoe would inherently be devoid of insoluble residues also. The concentrate can be diluted at a 1:15 ratio with additional water (col 8 line 15). In order to reverse the inhibition, acid can be added to lower the pH to 5-9 (col 7 line 40). This suggests applicant's claim 35. The pH adjustment is not always necessary (col 8 line 8).

Claims 24,25,27,28,31,32 and 34 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Brannon '026.

Brannon teaches guar based gels (abstract). Brannon adds 20 lbs + 100 lbs of polymer and buffer such as ammoniumhydroxide to 1000 gallons of water (col 5 line 18-

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25). The pH is 10-11 (col 5 line 26). The pH and polymer concentration correspond to applicant's preferred amounts (eg claims 31,34) and therefore it is presumed that no gelling agent residue remains.

Applicant's arguments filed 6/30/06 have been fully considered but they are not persuasive.

Applicant argues Briscoe's reversal of the hydration inhibition would form a water insoluble residue.

This is not convincing. Briscoe does not disclose his composition contains such residue. Column 7 lines 29-57 cited by applicant, does not refer to any insoluble residues.

Applicant argues the inhibitor-less example of Briscoe's table I is not a hydratable gelling agent because of the reported viscosity.

This is not convincing. Applicant's claims have no viscosity limitations. Secondly, the hydratable polymer of this example (hydroxypropylguar) is applicant's preferred polymer in applicant's preferred amount. How is it possible the same material in the same amounts qualifies as viscous gelled treating fluid for applicant, but not for Briscoe? Finally, table III of Briscoe shows an example of a high viscosity guar/NaOH aqueous composition.

Applicant argues Brannon's composition would contain insoluble gelling agent residue.

This is not convincing. Applicant fails to point out any specific step that would provide the residue. Briscoe never indicates such residue is present. Broad sweeping

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allegations without any underlying explanation or scientific reasoning are never convincing. The only teaching applicant provides for removing the residue is to raise the pH (paragraph 6 of spec). Brannon (and Briscoe) raise the pH in the same manner. The references inherently must also be devoid of such residue. The examiner points to MPEP 2112 regarding rejections based on inherency.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Buttner

DAVID J. BUTTNER  
PRIMARY EXAMINER

8/2/06

